## Remarks

### I. Introduction

This is in response to the Office Action dated June 23, 2008. The Office Action rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0023691 to Knauerhase (Knauerhase) in view of U.S. Patent Application Publication No. 2004/0128356 to Bernstein et al. (Bernstein) and U.S. Patent Application Publication No. 2004/0193722 to Donovan (Donovan). Claims 1-20 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Knauerhase in view of Donovan and U.S. Patent No. 6,912,564 to Appelman et al. (Appelman).

Claims 1-20 remain for consideration.

### II. Rejections under 35 U.S.C. §103(a)

Independent claim 1 was rejected as being unpatentable over Knauerhase in view of Bernstein and Donovan.

In order to "establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art." In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, "all words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See also MPEP § 2143.03. The cited references, either alone or in combination, do not teach all of the claim limitations of independent claim 1. Therefore, Applicants request the withdrawal of the rejection of claim 1 under 35 U.S.C. §103(a).

The subject matter of the present invention generally relates to the Internet and, more particularly, to systems and methods for integrating instant messaging (IM) services and email services.

The Abstract of the present Application states that "[i]n one embodiment, the email services and IM services are integrated through an address book database. The

address book database correlates email information of a contact with a reference identifier (ID). Additionally, one or more IM addresses of the contact are also correlated to the reference ID, thereby permitting further correlation of a contact's IM information with the contact's email information."

As shown in Figure 1 of the present Specification, "one embodiment of a system for integrating IM and email comprises a tray manager 102, an IM user agent 104, an email user agent 106, an address book object 108, and an address book database 110. In an example embodiment, the various components 102, 104, 106, 108, 110 may be seen as software modules, which are launched by a user on a personal computer (not shown)." (present Specification page 6, lines 17-23)

In one embodiment of the present invention shown in Figure 24 of the present Specification, a method for integrating email and IM services in which contact information is correlated to a contact identifier associated with a particular contact begins with receiving (2420) the contact information which is correlated (2430) to a contact identifier. As described with reference to Figures 12 through 13B, the contact information may comprise a full name, one or more email addresses, one or more IM addresses, one or more phone numbers, one or more mailing addresses and other detailed information related to the contact." (present Specification page 41, line 21 to page 42, line 4)

Figure 17 of the present specification "is a flowchart showing one embodiment of a method for integrating email and IM services in which IM Internet presence information is displayed on an email read window. As shown in FIG. 17, one embodiment of the method begins when an email message is received (1720) from a contact. The received (1720) email message has an email address of the contact. The received email message is displayed (1730) to a user. Additionally, IM presence information is displayed (1740) on the email message." (present Specification, page 38, line 23 to page 39, line 3)

Figure 18 of the present Specification "is a flowchart showing another embodiment of a method for integrating email and IM services in which an IM session

may be initiated from an email read window. As shown in FIG. 18, another embodiment of the method begins when an email message from a contact is displayed (1820) to the user at an email read window. The email message includes an email address of the contact. Upon displaying (1820) the email message to the user, the system awaits user input. When the user provides the user input, the user input is received (1830) at the displayed email message. In response to the received (1830) user input, an IM session is initiated (1840) between the user and the contact."(present Specification page 39, lines 11-20)

These aspects of the embodiments described above are claimed in independent claim 1 which recites:

> A method processed by a computing device at a user location, comprising:
>
> > receiving, by the computing device at the user location, an instant messaging (IM) address of a contact of a user;
> >
> > receiving, by the computing device at the user location, an email address of the contact of the user;
> >
> > receiving, by the computing device at the user location, the IM address to the reference identifier;
> >
> > receiving, by the computing device at the user location, a reference identifier (ID), the reference identifier (ID) being adapted to identify the contact of the user;
> >
> > correlating, by the computing device at the user location, the IM address to the reference identifier;
> >
> > correlating, by the computing device at the user location, the email address to the reference identifier (ID); and
> >
> > providing, by the computing device at the user location, an email receive window configured to display a received email, the email receive window configured to provide IM presence information associated with the IM address of the contact of the user, the email receive window configured to utilize reference identifier (ID) for automatically launching an IM session with the contact from the email receive window, directly from the email receive window, the email receive window including a launch IM option for launching the IM session.

The cited references do not disclose, either alone or in combination, each and every limitation of claim 1. As such, the cited references cannot render independent claim 1 unpatentable.

The Office Action states that Knauerhase discloses the limitations of "receiving, by the computing device at the user location, an instant messaging (IM) address of a contact of a user," "receiving, by the computing device at the user location, an email address of the contact of the user," "receiving, by the computing device at the user location, a reference identifier (ID), the reference identifier (ID) being adapted to identify the contact of the user," "correlating, by the computing device at the user location, the IM address to the reference identifier (ID), and "correlating, by the computing device at the user location, the email address to the reference identifier."

First, Applicants respectfully submit that Knauerhase does not disclose the limitations of "receiving, ..., an instant messaging (IM) address of a contact of a user," "receiving,..., an email address of the contact of a user," and "receiving, as required by independent claim 1. The "user" in independent claim 1 is the recipient of an email message. The "contact", to which the email address and IM address are related, is the sender of the email message. **The email address, IM address, as well as all other communication channels described in Knauerhase are associated with the recipient of a message and not the sender or "contact" as claimed in independent claim 1.** Further, Applicants have reviewed Knauerhase and it does not appear to Applicants that any section of Knauerhase discloses the recipient of a message knowing anything about the sender.

Second, Applicants respectfully submit that Knauerhase does not disclose the limitations of "receiving," "correlating," and "providing," "by the computing device at the user location." Knauerhase paragraph 15 indicates that "[t]he presence routing architecture 300 (shown in Figure 3, which contains the communication channel information shown in Figure 2 ) may be formed of four components 301-304, typically implemented as software entities residing and/or executing on one or more networked

computer platforms." Nowhere does Knauerhase disclose "receiving," "correlating," or "providing" "by the computing device at the user location" as recited in independent claim 1. The Office Action does not indicate that the above limitations are disclosed in either Bernstein or Donovan. Further, Applicants have reviewed Bernstein and Donovan and it does not appear to Applicants that either of the references discloses the limitations of "receiving," "correlating," and "providing," "by the computing device as the user location" as recited in independent claim 1.

Since the cited references, either alone or in combination, fail to disclose each and every limitation of independent claim 1, the references cannot render independent claim 1 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1 under 35 U.S.C. 103(a) over Knauerhase, in view of Bernstein and Donovan.

Independent claim 6 was rejected under 35 U.S.C. 103(a) over Knauerhase in view of Bernstein and Donovan. Independent claim 6 claims a "method processed by a computing device at a user location, comprising," with limitations reciting "receiving," "correlating," and "providing," "by the computing device at the user location" similar to the limitations of independent claim 1. The cited references fail to disclose, either alone or in combination, each and every limitation of independent claim 6 for reasons discussed above in connection with independent claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 6 under 35 U.S.C. 103(a) over Knauerhase, in view of Bernstein and Donovan.

Independent claim 11 was rejected under 35 U.S.C. §103(a) over Knauerhase in view of Bernstein and Donovan. Independent claim 11 claims a system which includes "first receive logic configured to receive first user input, the first user input comprising multiple instant messaging (IM) addresses of an individual contact of the user" "second receive logic configured to receive second user input, the second user input comprising a reference identifier (ID)" and "correlate logic configured to correlate each of the multiple IM addresses to the reference identifier (ID)." Each of the "logic" limitations is

"processed by the computing device at the user location." The "logic" included in each of the limitations of independent claim 11are configured to perform operations similar to the limitations of the method of independent claim 1. Therefore, the cited references do not disclose the limitations of independent claim 11 for reasons similar to those discussed above in connection with independent claim1. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 11 under 35 U.S.C. 103(a) over Knauerhase in view of Bernstein and Donovan.

Independent claim 1 also rejected under 35 U.S.C. 103(a) over Knauerhase, Donovan and Appelman. The limitations of "receiving," "correlating," and "providing," "by the computing device at the user location" are not disclosed by Knauerhase or Donovan for reason discussed above in connection with independent claim 1 above. Appelman fails to disclose the limitations missing from Knauerhase and Donovan.

Appelman discloses a system for instant messaging the sender and recipients of an e-mail message. The Abstract of Appelman states:

> Systems and techniques for transferring electronic data between users of a communications system include a host system structured and arranged to receive and deliver messages of various types between users of the communications system. The **host system includes** an instant messaging network; a mail gateway; and **a configuring network** in communication with both the instant messaging network and the mail gateway...The configuring network is dedicated to automatically configuring instant messaging communication between an intended recipient of an e-mail message and the sender of the e-mail message.

As indicated above, Appelman discloses a "configuring network...dedicated to automatically configuring instant messaging communication between an intended recipient of an e-mail message and the sender of the e-mail message." Appelman does not disclose the limitations of "receiving," "correlating" and "providing" "by the computing device at the user location" as required by claim 1. Although Appelman discloses "a look-up server for associating email addresses with instant messaging screen names,"

this look-up server is included in the "configuring network" which, as stated above, is part of the "host system" which is not "at the user location" as recited in claim 1.

For reasons discussed above, Appelman fails to disclose the limitations missing from Knauerhase and Donovan. As such, the cited references, either alone or in combination, fail to disclose each and every limitation of independent claim 1. As such, the cited references cannot render independent claim 1 unpatentable. Accordingly, Applicants respectfully request withdrawal of the rejection of independent claim 1 under 35 U.S.C. §103(a) over Knauerhase, Donovan and Appelman.

Independent claim 6 was also rejected under 35 U.S.C. 103(a) over Knauerhase, Donovan and Appelman. Independent claim 6 claims a method processed by a computing device at a user location, comprising," with limitations reciting "receiving," "correlating," and "providing," "by the computing device at the user location" similar to the limitations of independent claim 1. Therefore, the cited references fail to disclose, either alone or in combination, each and every limitation of independent claim 6 for reasons discussed above in connection with independent claim 1.

Independent claim 11 was rejected under 35 U.S.C. §103(a) over Knauerhase in view of Donovan and Appelman. Independent claim 11 claims a system which includes "first receive logic configured to receive first user input, the first user input comprising multiple instant messaging (IM) addresses of an individual contact of the user" "second receive logic configured to receive second user input, the second user input comprising a reference identifier (ID)" and "correlate logic configured to correlate each of the multiple IM addresses to the reference identifier (ID)." Each of the "logic" limitations is "processed by the computing device at the user location." The "logic" included in each of the limitations of independent claim 11 are configured to perform operations similar to the limitations·of the method of independent claim 1. Therefore, the cited references do not disclose the limitations of independent claim 11 for reasons similar to those discussed above in connection with independent claim1. Accordingly, Applicants

respectfully request withdrawal of the rejection of independent claim 11 under 35 U.S.C. 103(a) over Knauerhase in view of Donovan and Appelman.
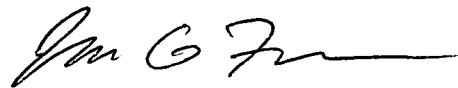
For the reasons discussed above, all independent claims are allowable over the cited art. Allowance of all independent claims is requested.

All remaining dependent claims are dependent upon an allowable independent claim and are therefore also allowable.

## III. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

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Date: October 22, 2008
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